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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,854	12/31/2001	Corine Vemet	21402-230 (CURA-530)	5243

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EXAMINER

ALLEN, MARIANNE P

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/038,854

Applicant(s)

SPYTEK ET AL

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005 and 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-47 and 49-63 is/are pending in the application.
- 4a) Of the above claim(s) 53, 54, 56, 58, 60 and 62 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42, 44, 46, 47, 49 and 50 is/are allowed.
- 6) ☒ Claim(s) 43, 45, 51, 52, 55, 57, 59, 61, 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 42-47 and 49-63 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Applicant's arguments with respect to claims 42-47, 49-52, 55, 57, 59, 61, and 63 have been considered but are moot in view of the new ground(s) of rejection.

Claims 53, 54, 56, 58, 60, and 62 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

#### ***Specification***

The substitute specification filed 10/15/02 has been entered.

#### ***Inventorship***

In view of the papers filed 7/25/05, the inventorship in this nonprovisional application has been changed by the deletion of inventors Spytek, Li, Wolenc, Eisen, Liu, Malyankar, Shimkets, Tchernev, Spaderna, Gorman, Kekuda, Gusev, Gangolli, Guo, Shenoy, Rastelli, Casman, Boldog, Burgess, Edinger, Ellerman, Gunther, Smithson, Millet, and MacDougall. The two remaining inventors are Meera Patturajan and Corine Vernet.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

#### ***Claim Rejections - 35 USC § 112***

Claims 43, 45, 51, 52, 55, 57, 59, 61, and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

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Claims 43, 45, 51, 52, 55, 57, 59, 61, and 63 are not originally filed claims.

Claims 43 and 51 are directed to the mature form of SEQ ID NO: 38. However, the specification does not describe the identity of the amino acids present in the mature form. No signal peptide, prepro forms or other precursor forms that are later cleaved are disclosed for the polypeptide of SEQ ID NO: 38. See substitute specification particularly at page 128. If SEQ ID NO: 38 is itself the mature form, then claim 43 does not differ in scope from claim 42. Use of the language “encodes a mature form” (bold added) in claim 51 implies that there may be multiple mature forms. There is no basis in the specification for this concept and none has been pointed to by applicant. Applicant is requested to point to basis in the specification for the identity of the mature form of SEQ ID NO: 38.

Claim 45 recites “encoding the full length complement.” There is no basis for this phrase in the specification and it is unclear what is intended. SEQ ID NO: 37 is a polynucleotide and is not encoded. A polypeptide is encoded by a polynucleotide. If applicant intended to claim an isolated polynucleotide comprising a nucleic acid sequence **that is** the full length complement of the polynucleotide SEQ ID NO: 37, then the claim should be amended. Amendment of the claim in this manner would obviate all rejections with respect to this claim.

Claims 52, 55, 57, 59, 61, and 63 are directed to single nucleotide polymorphism coding variants. Basis was stated to be in Table 29. However, this Table is for Nov15a (i.e. SEQ ID NOS: 35 and 36) and not Nov15b (SEQ ID NOS: 37 and 38). The specification does not disclose variants at amino acids residues 27, 39, 76, 220, 236, and 270 for SEQ ID NO: 38. While related, Nov15a and Nov15b do not have the same nucleotide or amino acid sequences. Clarification is requested.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 52, 55, 57, 59, 61, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 52, 55, 57, 59, 61, and 63 are directed to single nucleotide polymorphism coding variants for amino acids residues 27, 39, 76, 220, 236, and 270 of SEQ ID NO: 38. It is noted that the specified amino acid residues named in these claims are already present in SEQ ID NO: 38. That is, amino acid 27 of SEQ ID NO: 38 is already serine. Thus, it is unclear what applicant is intending to claim, particularly in view of the dependency of these claims on claim 42 which is directed to SEQ ID NO: 38. As written, the amino acids named are not variants. If SEQ ID NO: 38 is not the base structure which is modified, then the claim is confusing because it only identifies a single amino acid that must be present in the variant. Clarification is requested.

***Conclusion***

Claims 42, 44, 46, 47, 49, and 50 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marianne P. Allen  
Primary Examiner  
Art Unit 1647

10/12/05

mpa